

EXHIBIT 1



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,324	11/09/2006	6107851	10414-25	6695

7590 12/19/2006

BRADLEY J. BEREZNAK, EQS.
 BLAKELEY, SOKOLOFF, TAYLOR, ZAFMAN LLP.
 12400 WILSHIRE BOULEVARD
 SEVENTH FLOOR
 LOS ANGELES, CA 90025

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 12/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Case No. 04-1371-JJF
 DEFT Exhibit No. DX 601
 Date Entered _____
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12/19/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SANJEET K. DUTTA
ORRICK, HERRINGTON & SUTCLIFFE LLP
1000 MARSH ROAD
MENLO PARK, CA 94025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008324

PATENT NO. 6,107,851

ART UNI 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/008,324	6107851	
	Examiner	Art Unit	
	Margaret Rubin	3992	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 09 November 2006 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,
b) ☐ by credit to Deposit Account No. _____, or
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Margaret Rubin
Primary Examiner
Art Unit: 3992

cc:Requester (if third party requester)

Application/Control Number: 90/008,324

Page 2

Art Unit: 3992

DECISION GRANTING EX PARTE REEXAMINATION

Information Submissions

Information Submissions in *Ex Parte* Proceedings are bound by 37 CFR § 1.555 which incorporates 37 CFR § 1.98(a). Establishing a publication date for non-patent literature is among the requirements of 37 CFR § 1.98(a). Insofar as Requester has not provided the same for citation CE, this reference has not been considered and has been lined through on the information disclosure statement. Furthermore, it appears as if Requester made a typographical error in transcribing the title of citation CB and page numbers were not supplied for citations CC and CD. Corrections have been made by the Office on PTO form 1449.

Summary

Substantial new questions of patentability affecting claims 1, 2, 4, 7, 9, 10, 11, 13, 16 and 17 of United States Patent No.

Application/Control Number: 90/008,324

Page 3

Art Unit: 3992

6,107,851 (hereafter "the base patent") are raised by the following references¹:

¹ An SNQ is not raised by LM3101 Secondary-Side PWM Controller; National Semiconductor, cite "CE" of the IDS, because Requester has not established that a publication date for the document. Thus, whether it qualifies as prior art under 35 USC 102 is unknown.

Application/Control Number: 90/008,324

Page 4

Art Unit: 3992

- 1.) SGS-Thomson TEA 2262 Datasheet, "Switch Mode Power Supply Controller", pp 1-9, (April 1996) (hereafter, "TEA 2262");
- 2.) SGS-Thomson TEA 2260/TEA2261, Datasheet Application Note 376, "High Performance Driver Circuits for S.M.P.S." pp. 1-33 (June 1994) (hereafter, "TEA 2260/2261");
- 3.) PWM Power Supply IC; 85-265 VAC Input Isolated, Regulated DC Output, Power Integrations SMP211 Datasheet (January 1996) (hereafter, "SMP 211");
- 4.) U.S. Patent No. 4,638,417 to Martin;
- 5.) "Programmed Pulsewidth Modulated Waveforms for Electromagnetic Interference Mitigation in DC-DC Converters"; IEEE Transactions on Power Electronics, Vol. 8, No.4 (October 1993) by A.C. Wang and S.R. Sanders, pp. 596-605 (hereafter "Wang");
- 6.) U.S. Patent No. 5,498,995 to Szepesi et al., (hereafter "Szepesi"); and
- 7.) "Off-Line Power Integrated Circuit for International Rated 60-watt Power Supplies" by Richard Keller, Applied Power Electronics Conference and Exposition, February 1992 (pp. 505-512) (hereafter, "Keller").

Application/Control Number: 90/008,324

Page 5

Art Unit: 3992

Issues Raised by Requester

Although the merits of the rejections suggested in the request are not decided herein, it is noted that the Requester proposes that the references supplied raise substantial new questions of patentability when viewed in the following manner:

- 1.) Claims 1, 2, 4, 7, 9, 10, 11, 13, 16 and 17 are rejected under 35 U.S.C. §§102(a)(b) as anticipated by TEA 2262;
- 2.) Claims 1, 2, 4, 7, 9, 10, 11, 13, 16, and 17 are rejected under 35 U.S.C. §§102(a)(b) as anticipated by SMP211 in light of the admitted prior art of the patent;
- 3.) Claims 1, 2, 7, 9, 10, 11, 16, and 17 are rejected under 35 U.S.C. §§102(a)(b) as anticipated by Martin;
- 4.) Claims 1, 2, 7, 9, 10, 11, 16, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of SMP211;
- 5.) Claims 4 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Keller;
- 6.) Claims 1, 2, 7, 9, 10, 11, 16, and 17 are rejected under 35 U.S.C. §§102(a)(b) as anticipated by Wang;

Application/Control Number: 90/008,324

Page 6

Art Unit: 3992

7.) Claims 4 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Keller; and

8.) Claims 1, 2, 7, 9, 10, 11, 16, and 17 are rejected under 35 U.S.C. §§102(a)(b) as anticipated by Szepesi.

Background

The base patent issued from United States Patent Application No. 09/080,774 (hereafter "the base application"). Although Office records of the prosecution history of the base application are not currently available and will not be available in a timely manner for purposes of deciding this request, insofar as Requester has provided papers from the prosecution history, they have been reviewed to determine what claim limitations were deemed patentable. It is noted that a statement regarding allowable subject matter dated December 13, 1999 cited "a PWM switch comprising an oscillator [sic] for generating a maximum duty cycle signal and a signal [sic] with a frequency range dependent on a frequency variation circuit as recited in claim 1." It is noted that there are two independent claims within the base patent: claims 1 and 11. Neither of them include recitation of a signal with a frequency range dependent on a frequency variation circuit. In addition, claim 11 does not

Application/Control Number: 90/008,324

Page 7

Art Unit: 3992

require a PWM switch. Lastly, from the records supplied by Requester, it appears as if a Statement of Reasons for Allowance was not made when the base application was allowed.

In summary, the prosecution history does not provide a clear record of the reasons the base patent was allowed.

Issues

TEA 2262 and TEA 2260/2261

It is agreed that TEA 2262 and TEA 2260/2261 raise an SNQ for claims 1 and 11. Insofar as Requester has grouped these references together for presentation, they have been evaluated together herein. (That said, these references could not fairly be treated as a single publication for purposes of making a rejection under 35 USC 102 as suggested by Requester.) More particularly, Requester has provided plausible item-matching for a number of limitations of claims 1 and 11 on pages 10-15 and 20-26, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings presented in the request cannot be judged as merely cumulative. By raising an SNQ with regard to the independent claims, an SNQ is also raised

Application/Control Number: 90/008,324

Page 8

Art Unit: 3992

for the dependent claims 2, 4, 7, 9, 10, 13, 16 and 17 which come freighted with the limitations of the claims from which they stem.

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

SMP211

It is agreed that SMP 211 raises an SNQ for claims 1 and 11. More particularly, Requester has provided plausible item-matching for a number of limitations of claims 1 and 11 on pages 31-34 and 39-42, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings presented in the request cannot be judged as merely cumulative. By raising an SNQ with regard to the independent claims, an SNQ is also raised for claims 2, 4, 7, 9, 10, 11, 13, 16 and 17 which come freighted with the limitations of the claims from which they stem.

Application/Control Number: 90/008,324

Page 9

Art Unit: 3992

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

Martin

It is agreed that Martin raises an SNQ for claims 1 and 11. More particularly, Requester has provided plausible item-matching for a number of limitations of claims 1 and 11 on pages 46-49 and 55-59, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings presented in the request cannot be judged as merely cumulative. By raising an SNQ with regard to the independent claims, an SNQ is also raised for claims 2, 4, 7, 9, 10, 13, 16 and 17 which come freighted with the limitations of the claims from which they stem.

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination

Application/Control Number: 90/008,324

Page 10

Art Unit: 3992

and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

Keller

It is agreed that Keller raises an SNQ for claims 4 and 13. More particularly, Requester has provided plausible item-matching for a number of limitations of claims 4 and 13 at least on pages 50-51 and 59-60, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings presented in the request cannot be judged as merely cumulative.

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

Wang

It is agreed that Wang raises an SNQ for claims 1 and 11. More particularly, Requester has provided plausible item-

Application/Control Number: 90/008,324

Page 11

Art Unit: 3992

matching for a number of limitations of claims 1 and 11 on pages 67-70 and 75-79, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings presented in the request cannot be judged as merely cumulative. By raising an SNQ with regard to the independent claims, an SNQ is also raised for claims 2, 4, 7, 9, 10, 11, 13, 16 and 17 which come freighted with the limitations of the claims from which they stem.

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

Szepesi

It is agreed that Szepesi raises an SNQ for claims 1 and 11. More particularly, Requester has provided plausible item-matching for a number of limitations of claims 1 and 11 on pages 84-89 and 94-100, respectively, of the request. In view of the fact that the prosecution history does not provide a clear record of the reasons the base patent was allowed, the teachings

Application/Control Number: 90/008,324

Page 12

Art Unit: 3992

presented in the request cannot be judged as merely cumulative. By raising an SNQ with regard to the independent claims, an SNQ is also raised for claims 2, 4, 7, 9, 10, 11, 13, 16 and 17 which come freighted with the limitations of the claims from which they stem.

Such teachings are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination and the same question of patentability was not the subject of a final holding of invalidity by Federal Courts.

Conclusion

Since Requester did not request reexamination of claims 3, 5, 6, 8, 12, 14, 15 and 18 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims, these claims will not be reexamined unless at the discretion of the Office.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires

Application/Control Number: 90/008,324

Page 13

Art Unit: 3992

that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No 6,107,851 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

Please FAX any communications to:
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Central Reexamination Unit

Application/Control Number: 90/008,324

Page 14

Art Unit: 3992

Please hand-deliver any communications to:

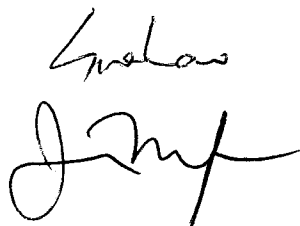
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Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.



Margaret Rubin
Primary Examiner
Central Reexamination Unit 3992
(571) 272-1756

conferees:



Please type a plus sign (+) in this box ☐

PTO/SB/08A (10-96)

Approved for use through 10/31/99. OMB 0651-0031

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Patent Number	6,107,851
		Issue Date	June 19, 2001
		First Named Inventor	Balu Balakirshnan
		Group Art Unit	3992
		Examiner Name	Rubin
Sheet 1 of 1	Attorney Docket Number		

U.S. PATENT DOCUMENTS					
Examiner Initials	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Patent of Cited Documents MM-DD-YYYY
		Number	Kind Code ²		
MR	AA	4,638,417		Hubert C. Martin, Jr., et al.	January 20, 1987
MR	AB	5,498,995		Thomas Szepesi	March 12, 1996

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publications of Cited Documents MM-DD-YYYY
		Office ³	Number ⁴	Kind Code ⁵		
	BA					

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
MR	CA	SGS-Thomson Microelectronics TEA 2262; Switch Mode Power Supply Controller; pages 1-9; April 1996	
MR	CB	SGS-Thomson Microelectronics TEA 2262/TEA2261; High Performance Driver Circuits for S.M.P.S; pages 1-33; June 1994	
MR	CC	PWM Power Supply IC; 85-265 VAC Input Isolated, Regulated DC Output; Power Integrations SMP211 Datasheet (January 1996) ("SMP 211")	
MR	CD	"Programmed Pulsewidth Modulated Waveforms for Electromagnetic Interference Mitigation in DC-DC Converters; IEEE Transactions on Power Electronics, Vol. 8, No. 4 (Oct 1993) A.C. Wang, S.R. Sanders	
	CE	LM3101 Secondary-Side PWM Controller; National Semiconductor; Szepesi	
MR	CF	Off-Line Power Integrated Circuit For International Rated 60 Watt Power Supplies; Richard Keller, Power Integrations Inc. Page 505-512, IEEE 1992	

PP 596-605

Examiner Signature	OHS West:260122431.1	Date Considered	12/8/06
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XAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.)). ⁴For Japanese patent documents, indication of the year of the reign of the Emperor must precede the serial number of the patent documents. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

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